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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,686	06/04/2001	Charles Ickowicz	430/1/001	4782

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EXAMINER
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DASS, HARISH T

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/873,686	ICKOWICZ, CHARLES	
	<b>Examiner</b>	<b>Art Unit</b>	
	Harish T Dass	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/8/03, 6/4/01, 6/</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural

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phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the

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"technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

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§101 rejection finding the claimed invention to be non-statutory. See Ex parte Bowman, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claims 1, 3-11 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts; for example: "computer is used to calculate average , etc which is/are supported by the specification".

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 7-11 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Alan Copps, August 12, 1995 "Fast Lane to a Mercedes for every season" (hereinafter - Copps) in view of Applicant declaration.

Re. Claim 1, Copps discloses setting a total lease term (minimum three years); selecting a plurality of different vehicles in a plurality of different time periods to be

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driven by a lessee during the total lease term (E200 saloon & E200 Estate); calculating lease costs to the lessee during said total lease term in dependence upon at least the plurality of different vehicles to be driven by the lessee in the plurality of different time periods during the total lease term (extra pounds for upgrades); entering into a lease agreement with said lessee for said plurality of different vehicles in said plurality of different time periods during the total lease term (personal leasing schemes) [see entire documents, specially pages 1/4 and 2/4]. Copps does not explicitly disclose compiling information as to vehicles available for leasing and time periods in which the vehicles are available for leasing. However, Applicant admits vehicle rental, leasing of vehicle and return of vehicles (pages 1-2) and therefore, compiling information as to vehicles available for leasing and time periods in which the vehicles are available for leasing is well known to one skill in the art of renting/leasing motor vehicles. For example, a customer calls AVIS 800 number (or visits the rental office) to rent a car (for period of time such as days, weeks or months), AVIS agent checks the database (using terminal connected to main computer or server) which keeps track of all the rental cars available for rent at a time, which have been rented out and those will be dropped off. Based on the information (database) an AVIS rental clerk (agent) can promises a new customer which car he/she can rent on that particular day. Therefore It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify disclosure of Copps and include compiling information as to vehicles available for leasing and time periods in which the vehicles are available for leasing to be able to

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keep track of vehicles, when they will be dropped off, what is available at a time and how they can be rented again to maximize the company profit.

Re. Claim 3, claim 3 is rejected with same rational as claim 1 (see example).

Re. Claim 4, Copps further discloses including the step of selecting a manner of payment prior to said step of entering (3<sup>rd</sup> paragraph – monthly leasing payment) [page 2].

Re. Claims 7-9, Copps discloses wherein said step of selecting includes the step of selecting a sequence and timing of said selected vehicles and time periods during said lease term, wherein said time periods are each of equal duration during said lease term, and wherein at least some of said time periods are of different duration during said lease term (E200, E220, three years, 5 years) [see pages 1-4].

Re. Claims 10-11, Copps discloses wherein said step of entering includes the steps of printing out a copy of said lease agreement and having said lessee sign said printed out lease agreement and wherein the step of entering includes the step of providing electronic authorization to enter into said lease (credit approval) [0083].



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Claims 2, 5-6 and 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copps and Applicant declaration (hereinafter Applicant), as apply to claim 1 above, and further in view of Johnson (PGPUB US 2002/0082860).

Re. Claim 2 discloses Copps does not explicitly disclose the step of storing said compiled information on a storage medium of a computer system. However, Johnson discloses this step [para. 0062] to store various data and information of vehicles including service for lease. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures Copps, applicant's declaration and Johnson to provide computer with database to store vehicle information including vehicle lease, etc.

Re. Claim 5, discloses Johnson further discloses the step of returning to said step of selecting if said step of calculating results in unacceptable costs (calculated in any number of methods – para. 0069) [paragraphs 0066-0069; 0074] to calculate profit margin. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures Copps, applicant's and Johnson to determine contributed value of profit margin.

Re. Claim 6, Copps discloses wherein said step of selecting a manner of payment includes the step of selecting a manner of payment from one of the following: a) a periodic cost which varies in each period dependent upon a vehicle selected during

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each respective time period; b) a periodic cost which is constant in each time period; c) a lump sum payment; and d) a combination of a) through c) [page 2].

Re. Claims 12 and 14, Copps further discloses setting a total lease term (minimum three years); selecting a plurality of different vehicles in a plurality of different time periods to be driven by a lessee during the total lease term (E200 saloon & E200 Estate); calculating lease costs to the lessee during said total lease term in dependence upon at least the plurality of different vehicles to be driven by the lessee in the plurality of different time periods during the total lease term (extra pounds for upgrades); entering into a lease agreement with said lessee for said plurality of different vehicles in said plurality of different time periods during the total lease term (personal leasing schemes) and determines if said selected plurality of different vehicles input by said input device are available during said plurality of different time periods, and if not, requiring a new selection of a plurality of different vehicles in a plurality of different time periods to be driven by a lessee during the total lease term [see entire documents, specially pages 1/4 and 2/4]. Copps does not explicitly disclose compiling information as to vehicles available for leasing and time periods in which the vehicles are available for leasing, storage medium, input device, and central processing unit. However, Applicant admits vehicle rental, leasing of vehicle and return of vehicles (pages 1-2) and therefore, compiling information as to vehicles available for leasing and time periods in which the vehicles are available for leasing is well known to one skill in the art of renting/leasing motor vehicles. For example, a customer calls AVIS 800 number (or

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visits the rental office) to rent a car (for period of time such as days, weeks or months), AVIS agent checks the database (using terminal connected to main computer or server) which keeps track of all the rental cars available for rent at a time, which have been rented out and those will be dropped off. Based on the information (database) an AVIS rental clerk (agent) can promises a new customer which car he/she can rent on that particular day. Johnson discloses a system for leasing vehicle [Abstract; figure 1], storage medium (hard drive), input device (user interface device), and central processing unit (CPU) [figure 1; paragraphs 0001-0008; 0051-0054] to provide generate automatic quoting system for leasing vehicle. Therefore It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify disclosures of Copps & Applicant and include a leasing system, as disclosed by Johnson, and compiling information as to vehicles available for leasing and time periods in which the vehicles are available for leasing to enable the vehicle leasing companies to utilize computer system to keep track of leasing vehicle, when they will be dropped off, what is available at a time and how they can be rented again to maximize the company profit.

Re. Claim 13, Johnson further discloses a monitor connected with said central processing unit for displaying said compiled information and results of said calculation (display) [paragraph 0049-0052] to provide user interface for displaying documents and data. It would have been obvious to one of ordinary skill in the art at the time the

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Applicant's invention was made to combine disclosures Copps, Applicant and Johnson to include monitor for visual evaluation of computer progress.

Re. Claims 15-16, Copps discloses calculates the lease costs for each selected vehicle, and then calculates total lease costs for said lease term for all vehicles based on the calculated lease costs for each selected vehicle, wherein each selected vehicle has a preset cost associated therewith, and said central processing unit calculates total lease costs for said lease term for all vehicles based on the preset costs [pages 1-4].

Re. Claim 17, Johnson further discloses wherein said input device provides a manner of payment during said lease term (user interface) [see Figures; paragraphs 0049-0054; 0066-0069] to display the HTML document on screen.

Re. Claim 18, Copps disclose a) a periodic cost which varies in each period dependent upon a vehicle selected during each respective time period; b) a periodic cost which is constant in each time period; c) a lump sum payment; and d) a combination of a) through c) [page 2].

Re. Claims 19-21, Copps discloses wherein said one of said input device and said central processing unit selects a sequence and timing of said selected vehicles and time periods during said lease term, wherein said time periods are each of equal duration

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during said lease term, and wherein at least some of said time periods are of different duration during said lease term (E200, E220, three years, 5 years) [see pages 1-4].

### ***Conclusion***

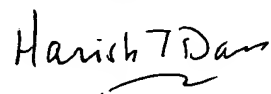
Claims 1-21 are rejected with reasons stated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Souh can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass  
Examiner  
Art Unit 3628



4/4/05